

O/0769/23

TRADE MARKS ACT 1994

IN THE MATTER OF APPLICATION NO. UK00003735299
BY CONTEMPORATRY AMPEREX TECHNOLOGY CO., LIMITED
TO REGISTER THE FOLLOWING MARK:

NBattery

IN CLASS 9, 12 AND 37

AND

IN THE MATTER OF OPPOSITION THERETO
UNDER NO. 434651
BY CATERPILLAR INC.

BACKGROUND AND PLEADINGS

1. On 21 December 2021, Contemporary Ampere Technology Co., Limited (“the applicant”) applied to register the trade mark on the cover page of this decision in the UK. The application was published for opposition purposes on 29 April 2022. The applicant seeks registration for the following goods:¹

Class 9 Batteries, electric, for vehicles; charging stations for electric vehicles; Charging devices for motor vehicles; computer software platforms, recorded or downloadable; Downloadable mobile application software; computer software applications, downloadable.

Class 12 Electric vehicles; motorcycles; driverless cars [autonomous cars]; remote control vehicles, other than toys; motor coaches; sprinkling trucks; trucks; mine cars; motorcycles; motor buses; cars; Land vehicles; garbage trucks; tramcars; forklift trucks; vehicles for locomotion by land, air, water or rail; Electric self-balancing cars; electric bicycles; Mopeds; civilian drones; air vehicles; water vehicles; ferry boats.

Class 37 Providing information relating to repairs; electric appliance installation and repair; machinery installation, maintenance and repair; installation, maintenance and repair of computer hardware; rebuilding machines that have been worn or partially destroyed; interference suppression in electrical apparatus; vehicle maintenance; vehicle cleaning; vehicle breakdown repair services; vehicle battery charging; charging of electric vehicles; vehicle service stations [refuelling and maintenance]; Motor vehicle charging services.

2. The application was opposed by Caterpillar Inc. (“the opponent”) on 26 June 2022. The opposition is based upon sections 3(1)(b) and 3(1)(c) of the Trade Marks Act 1994 (“the Act”). In its Notice of Opposition, the opponent states:

¹ The opponent confirmed on 22 November 2022 that the Form 21B which was filed by the applicant on 11 November 2022, which limited the applicant’s class 9 specification, was not enough to overcome their opposition. I note that the above is the applicant’s amended specification.

“The word “battery” in the Contested Mark will be perceived as a direct reference to the designated products (in the case of batteries), to one of their main features (in the case of electric vehicles) or as a reference to the goods to which the designated services relate. The Contested Mark clearly refers, for the public, without further reflection, to characteristics or particular features of a battery as we discuss further below. This is in particular because:

- a) the letter “N” combined with “Battery” will be perceived as a type or size of battery, in fact there already exists a generic category of battery called “N” battery; and
- b) it is common to categorise types of sizes of battery by using single, double or triple letter code, hence there is a very real need for others to keep the term “NBattery” free for use.

For the above reasons the Contested Mark will clearly be perceived as directly referring to the following Class 9 goods: *“Batteries, electric, for vehicles; charging stations for electric vehicles; Charging devices for motor vehicles”*.

In relation to *“computer software platforms, recorded or downloadable; Downloadable mobile application software; computer software applications, downloadable”* in Class 9, the Application will be perceived as indicating the intended use of the goods, namely a battery type or size that fits or supports these products.

Likewise for the goods in Class 12: [...] the Contested Mark could be seen as an indication to a type of battery and its size. Moreover as we will show below the Contested Mark is even in generic use for vehicle batteries.

Regarding the services in Class 37: [...] the sign is understood by the consumer to mean installation, maintenance and repair services in relation to a specific

type or size of battery as well as computer software or vehicles equipped with such batteries.

[...]

Accordingly, the relevant public will perceive the Contested Mark as an indication to the characteristics or functions of the products and services themselves, rather than as an indication of origin.

[...]

In the present case, in addition to being descriptive of the goods and services covered in class 9, 12 and 37 pursuant to Section 3(1)(c) TMA, the Application is also non-distinctive within the meaning of Section 3(1)(b) TMA.

The Application simply informs the relevant public of a type or size of battery or that the goods and services concerned consist of or have nickel-containing batteries.

It follows from the above that the relevant public will not perceive the Application as an indication of commercial origin, nor will it be able to distinguish, without any possibility of confusion, the goods designated by the Application from those of different commercial origins.”

3. The applicant filed a counterstatement denying the claims made.

4. The opponent is represented by Hogan Lovells International LLP and the applicant is represented by Trademarkit LLP. Neither party requested a hearing, but the opponent filed two sets of evidence in chief. Both parties filed submissions in lieu of a hearing. This decision is taken following a careful perusal of the papers.

5. Although the UK has left the EU, section 6(3)(a) of the European Union (Withdrawal) Act 2018 requires tribunals to apply EU-derived national law in accordance with EU law as it stood at the end of the transition period. The provisions of the Act relied on in

these proceedings are derived from an EU Directive. This is why this decision continues to make reference to the trade mark case-law of EU courts.

EVIDENCE

6. The opponent's evidence in chief consists of the first witness statement of Ms Emily Sharkey, dated 20 October 2022. Ms Sharkey is a Solicitor and Senior Associate at Hogan Lovells International LLP, the representatives for the opponent. Ms Sharkey's statement was accompanied by 5 exhibits (ES1-ES5).

7. The opponent's evidence also consists of the second witness statement of Ms Sharkey dated 28 February 2023. This statement was not accompanied by any exhibits.

8. Whilst I do not propose to summarise it here, I have taken all of the evidence and the parties' submissions into consideration in reaching my decision and will refer to them where necessary below.

DECISION

9. Section 3(1)(b) and 3(1)(c) read as follows:

“3(1) The following shall not be registered –

(a) [...]

(b) trade marks which are devoid of any distinctive character,

(c) trade marks which consist exclusively of signs or indications which may serve, in trade, to designate the kind, quality, quantity, intended purpose, value, geographical origin, the time of product of goods or of rendering of services, or other characteristic of goods or services,

(d) [...]

Provided that, a trade mark shall not be refused registration by virtue of paragraph (b), (c) or (d) above if, before the date of application for registration, it has in fact acquired a distinctive character as a result of the use made of it.”

10. The relevant date for determining whether the mark is objectionable under sections 3(1)(b) and 3(1)(c) is the date of the application in issue, i.e. 21 December 2021.

11. I bear in mind that the above grounds are independent and have differing general interests. It is possible, for example, for a mark not to fall foul of section 3(1)(c) but still be objectionable under section 3(1)(b). In *SAT.1 SatellitenFernsehen GmbH v OHIM*, Case C-329/02 P, the Court of Justice of the European Union (“CJEU”) stated that:

“25. Thirdly, it is important to observe that each of the grounds for refusal to register listed in Article 7(1) of the regulation is independent of the others and requires separate examination. Moreover, it is appropriate to interpret those grounds for refusal in the light of the general interest which underlies each of them. The general interest to be taken into consideration when examining each of those grounds for refusal may or even must reflect different considerations according to the ground for refusal in question (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-0000, paragraphs 45 and 46).”

The Average Consumer

12. The position under the above grounds must be assessed from the perspective of the average consumer, who will be deemed to be reasonably observant and circumspect.² In this case, the average consumer will consist of members of the general public, business users and specialists in software, batteries and vehicles.

13. I consider that the average consumer for “computer software platforms, recorded or downloadable”, “downloadable mobile application software” and “computer software applications, downloadable” in class 9, would pay a medium degree of

² *Matratzen Concord AG v Hukla Germany SA*, Case C-421/04

attention during the purchasing process, considering factors such as suitability for the user's needs, ease of use and cost.

14. For the remaining class 9 goods ("batteries, electric, for vehicles", "charging stations for electric vehicles" and "charging devices for motor vehicles"), I consider that these are more expensive purchases and concern the overall working of the vehicle. Therefore, I consider that above a medium degree of attention will be paid during the purchasing process, including considering the compatibility of these goods with the users' vehicles.

15. The class 12 goods are all types of vehicles, which are big, expensive purchases and concern the safety of the driver. I therefore consider that the user would pay a high degree of attention during the purchasing process.

16. The same considerations apply in paragraph 14 above for the class 37 "vehicle maintenance", "vehicle breakdown repair services", "vehicle battery charging", "charging of electric vehicles", "vehicle service stations [refuelling and maintenance]" and "motor vehicle charging services". The user would pay a above a medium degree of attention during the purchasing process.

17. For the applicant's remaining class 37 services ("providing information relating to repairs", "electric appliance installation and repair", "machinery installation, maintenance and repair", "installation, maintenance and repair of computer hardware", "rebuilding machines that have been worn or partially destroyed", "interference suppression in electrical apparatus" and "vehicle cleaning"), these are infrequent purchases, which will vary in price, but will not be at the highest end of the scale. Considerations such as whether the services suit the user's needs and cost will be made by the average consumer. I therefore consider that a medium degree of attention will be paid during the purchasing process.

Section 3(1)(c)

18. I will begin with the opponent's objection under section 3(1)(c). Section 3(1)(c) prevents the registration of marks which are descriptive of the goods and services, or

a characteristic of them. The case law under section 3(1)(c) (corresponding to article 7(1)(c) of the EUTM Regulation, formerly article 7(1)(c) of the CTM Regulation) was set out by Arnold J. in *Starbucks (HK) Ltd v British Sky Broadcasting Group Plc* [2012] EWHC 3074 (Ch) as follows:

“91. The principles to be applied under art.7(1)(c) of the CTM Regulation were conveniently summarised by the CJEU in *Agencja Wydawnicza Technopol sp. z o.o. v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-51/10 P) [2011] E.T.M.R. 34 as follows:

“33. A sign which, in relation to the goods or services for which its registration as a mark is applied for, has descriptive character for the purposes of Article 7(1)(c) of Regulation No 40/94 is – save where Article 7(3) applies – devoid of any distinctive character as regards those goods or services (as regards Article 3 of First Council Directive 89/104/EEC of 21 December 1988 to approximate the laws of the Member States relating to trade marks (OJ 1989 L 40, p. 1), see , by analogy, [2004] ECR I-1699 , paragraph 19; as regards Article 7 of Regulation No 40/94 , see *Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM) v Wm Wrigley Jr Co* (C-191/01 P) [2004] 1 W.L.R. 1728 [2003] E.C.R. I-12447; [2004] E.T.M.R. 9; [2004] R.P.C. 18 , paragraph 30, and the order in *Streamserve v OHIM* (C-150/02 P) [2004] E.C.R. I-1461 , paragraph 24).

36. ... due account must be taken of the objective pursued by Article 7(1)(c) of Regulation No 40/94 . Each of the grounds for refusal listed in Article 7(1) must be interpreted in the light of the general interest underlying it (see, inter alia , *Henkel KGaA v Office for Harmonisation in the Internal Market (Trade Marks and Designs) (OHIM)* (C-456/01 P) [2004] E.C.R. I-5089; [2005] E.T.M.R. 44 , paragraph 45, and *Lego Juris v OHIM* (C-48/09 P) , paragraph 43).

37. The general interest underlying Article 7(1)(c) of Regulation No 40/94 is that of ensuring that descriptive signs relating to one or more

characteristics of the goods or services in respect of which registration as a mark is sought may be freely used by all traders offering such goods or services (see, to that effect, *OHIM v Wrigley* , paragraph 31 and the case-law cited).

38. With a view to ensuring that that objective of free use is fully met, the Court has stated that, in order for OHIM to refuse to register a sign on the basis of Article 7(1)(c) of Regulation No 40/94 , it is not necessary that the sign in question actually be in use at the time of the application for registration in a way that is descriptive. It is sufficient that the sign could be used for such purposes (*OHIM v Wrigley*, paragraph 32; *Campina Melkunie* , paragraph 38; and the order of 5 February 2010 in *Mergel and Others v OHIM* (C-80/09 P), paragraph 37).

39. By the same token, the Court has stated that the application of that ground for refusal does not depend on there being a real, current or serious need to leave a sign or indication free and that it is therefore of no relevance to know the number of competitors who have an interest, or who might have an interest, in using the sign in question (Joined Cases C-108/97 and C-109/97 *Windsurfing Chiemsee* [1999] ECR I2779, paragraph 35, and Case C-363/99 *Koninklijke KPN Nederland* [2004] ECR I-1619, paragraph 38). It is, furthermore, irrelevant whether there are other, more usual, signs than that at issue for designating the same characteristics of the goods or services referred to in the application for registration (*Koninklijke KPN Nederland*, paragraph 57).

And

46. As was pointed out in paragraph 33 above, the descriptive signs referred to in Article 7(1)(c) of Regulation No 40/94 are also devoid of any distinctive character for the purposes of Article 7(1)(b) of that regulation. Conversely, a sign may be devoid of distinctive character for the purposes of Article 7(1)(b) for reasons other than the fact that it may be descriptive (see, with regard to the identical provision laid down in

Article 3 of Directive 89/104, *Koninklijke KPN Nederland* , paragraph 86, and *Campina Melkunie*, paragraph 19).

47. There is therefore a measure of overlap between the scope of Article 7(1)(b) of Regulation No 40/94 and the scope of Article 7(1)(c) of that regulation (see, by analogy, *Koninklijke KPN Nederland*, paragraph 67), Article 7(1)(b) being distinguished from Article 7(1)(c) in that it covers all the circumstances in which a sign is not capable of distinguishing the goods or services of one undertaking from those of other undertakings.

48. In those circumstances, it is important for the correct application of Article 7(1) of Regulation No 40/94 to ensure that the ground for refusal set out in Article 7(1)(c) of that regulation duly continues to be applied only to the situations specifically covered by that ground for refusal.

49. The situations specifically covered by Article 7(1)(c) of Regulation No.40/94 are those in which the sign in respect of which registration as a mark is sought is capable of designating a 'characteristic' of the goods or services referred to in the application. By using, in Article 7(1)(c) of Regulation No 40/94 , the terms 'the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service, or other characteristics of the goods or service', the legislature made it clear, first, that the kind, quality, quantity, intended purpose, value, geographical origin or the time of production of the goods or of rendering of the service must all be regarded as characteristics of goods or services and, secondly, that that list is not exhaustive, since any other characteristics of goods or services may also be taken into account.

50. The fact that the legislature chose to use the word 'characteristic' highlights the fact that the signs referred to in Article 7(1)(c) of Regulation No 40/94 are merely those which serve to designate a property, easily recognisable by the relevant class of persons, of the goods or the services in respect of which registration is sought. As the Court has

pointed out, a sign can be refused registration on the basis of Article 7(1)(c) of Regulation No 40/94 only if it is reasonable to believe that it will actually be recognised by the relevant class of persons as a description of one of those characteristics (see, by analogy, as regards the identical provision laid down in Article 3 of Directive 89/104, *Windsurfing Chiemsee*, paragraph 31, and *Koninklijke KPN Nederland*, paragraph 56).”

92. In addition, a sign is caught by the exclusion from registration in art.7(1)(c) if at least one of its possible meanings designates a characteristic of the goods or services concerned: see *OHIM v Wrigley* [2003] E.C.R. I-12447 at [32] and *Koninklijke KPN Nederland NV v Benelux-Merkenbureau* (C-363/99 [2004] E.C.R. I-1619; [2004] E.T.M.R. 57 at [97].”

19. In *Campina Melkunie BV and Benelux-Merkenbureau*, Case C-265/00, the CJEU stated that:

“39. As a general rule, the mere combination of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, itself remains descriptive of those characteristics within the meaning of Article 3(1)(c) of the Directive even if the combination creates a neologism. Merely bringing those elements together without introducing any unusual variations, in particular as to syntax or meaning, cannot result in anything other than a mark consisting exclusively of signs or indications which may serve, in trade, to designate characteristics of the goods or services concerned.

40. However, such a combination may not be descriptive within the meaning of Art.3(1)(c) of the Directive, provided that it creates an impression which is sufficiently far removed from that produced by the simple combination of those elements. In the case of a word mark, which is intended to be heard as much as to be read, that condition will have to be satisfied as regards both the aural and the visual impression produced by the mark.

41. Thus, a mark consisting of a neologism composed of elements, each of which is descriptive of characteristics of the goods or services in respect of which registration is sought, is itself descriptive of those characteristics within the meaning of Art.3(1)(c) of the Directive, unless there is a perceptible difference between the neologism and the mere sum of its parts: that assumes that, because of the unusual nature of the combination in relation to the goods or services, the word creates an impression which is sufficiently far removed from that produced by the mere combination of meanings lent by the elements of which it is composed, with the result that the word is more than the sum of its parts.”

20. Firstly, within its evidence, the opponent has shown that the word “Battery” which forms the second element of the contested mark, is an ordinary dictionary word which is known to be a source of electric power. They can be used to power everyday items such as TV remotes and torches, but they can also be used within electric vehicles to power them.³ I note that the opponent has also provided articles within **exhibit ES1** which explain the importance of batteries in electric vehicles, which are commonly known as EV batteries. I note that the main information provided on batteries is within a blog from Energy Saving Trust, dated 10 November 2020, titled “Electric vehicle batteries: what you need to know”. It highlights that nearly all electric vehicles today “use lithium-Ion technologies for their ‘cells’ which when joined, form the battery”. An article from “ALL ABOUT CIRCUITS” dated 14 October 2020 highlights how the lithium-ion battery comes in 3 major forms; cylindrical, prismatic and pouch. I note that the remaining articles in **exhibit ES1** reinforce the above information and explore other aspects of batteries which are not relevant to my assessment.

21. Secondly, the opponent has provided evidence in **exhibit ES2** that the “N” element at the beginning of the contested mark, “is used to indicate a standard size of battery in the UK” which has the length of 30.2mm and diameter of 12.0mm. I note that only one article called “What are Alkaline Batteries?” from the BatteryGuy.com Knowledge base falls within the relevant period, dated 1 June 2020. It lists the following common

³ The opponent has provided multiple dictionary definitions of the word Battery at **exhibit ES1**.

alkaline battery sizes: D cells, C cells, AA cells, AAA cells, AAAA cells, N cells, 9Volt cells and Button cells.

22. The remaining evidence within **exhibit ES2** is either dated 24 March 2022, 5 October 2022 or 17 June 2022 and therefore falls after the relevant date. However, I note the following:

- A screenshot dated 24 March 2022 of a blog from jayconsystems.com looks at the different types of batteries and depicts the following picture of a battery with the letter “N” underneath:



- A screenshot dated 24 March 2022 from the website deamstime.com also depicts the following alkaline batteries, including “N”:



- A screenshot from alinc.com shows an “nBattery” for sale for \$99.50.
- A screenshot from primetenders.com lists a “LEAD ACID NBATTERY”. Under description it says, “for motor vehicle voltage”. It also shows the location of “West Bengal” and that the item was published on 8 November 2021.

- 2 screenshots from cpc.farnell.com show 2 “N Battery Holder Black Coil Spring Contact” being sold for up to £0.35p, and 2 sets of “Super Alkaline N Batteries” either in a 2 pack being sold for up to £1.92 or a 20 pack being sold for up to £11.82.
- Another screenshot from cpc.farnell.com shows the “Alkaline LR1/N Battery, 5 pack” being sold for £1.99. I note that this screenshot shows a little Great Britain flag on the top right hand corner of the website which indicates that “CPC” could be a UK supplier.
- A screenshot from batterystation.co.uk shows the “Panasonic LR1 N Battery”.
- 3 screenshots from Argos, Boots and Curry’s showing the sale of the “Duracell Speciality N Alkaline Battery” for £5.00.
- A screenshot from eBay showing the sale of a JCB battery which has the letter “N” in bold at the top left hand corner of the battery’s packaging for £1.99.
- 2 screenshots from uk.gpbatteries.com showing the sale of “GP Extra Alkaline N” batteries priced at £6.99 and “GP Alkaline Battery N” priced at £1.99.
- 12 screenshots from Amazon.co.uk showing the sale of some of the above N batteries (GP and Duracell), as well as the “Pickle Power N Size Ni-Mh Battery”, “VARTA LR1/N/LADY” battery and the “N/LR1” KODAK battery.
- A screenshot from kodakbatteries.com also shows the “N-LR1” KODAK battery.
- A screenshot from kitronik.co.uk lists the “12 Volt N Size Battery” as in stock.
- 2 screenshots from Amazon.com listing the “20” or “5” X PoundMax 910A LR1 N Type MN9100 1.5V Alkaline Batteries” for sale at £6.49 or £2.79.

- A screenshot from Amazon.com listing the “Duracell 10 x Duracell Lr1 Alkaline Security Batteries Clock Mn9100 N Type 910A” for sale at £8.99.
- A screenshot from Amazon.com listing the “KENDAL Ultra Power Alkaline 1.5v MN9100 LR1 N Size Batteries 4 count” for sale at £6.59.
- A screenshot from fabtolab.com showing the “2 pack N-type 1.5V Battery” in stock.

23. Ms Sharkey also states that while the letter N is used to indicate the size of the battery, “in addition, or in the alternative, while the chemical symbol for Nickle is “Ni”, the average UK consumer may still understand that the letter “N”, when used in relation to batteries, refers to the fact that they may contain nickel”. To support this notion, I note that **exhibit ES3** contains articles and Wikipedia printouts, which state that nickel has widely been used as a component for batteries, in particular rechargeable batteries, including for electric vehicles.

24. I note that the printouts within **ES3** are all dated 24 March 2022, with some specific articles having earlier dates, including a screenshot from Science Direct which contains multiple extracts from sources dated from 2009 to 2021. However, all of the articles and evidence within this exhibit refers to nickel-metal hydride batteries as Ni-MH or NiMH batteries. I note that the Nickel-Cadmium battery is also referred to as NiCD. This is supported by the following extract from BatteryGuy.com, in an article called “What are Nickel based batteries” dated 1 June 2020:

Nickel battery sizes

The most common commercially available nickel based battery sizes are:

- D cells
- C cells
- AA cells
- AAA cells
- Sub-C (also known as SC) cells
- 9 Volt
- Button

Nickel battery types

Nickel based batteries come in a variety of chemistries:

- Nickel Iron (NiFe)
- Nickel Zinc (NiZn)
- Nickel Cadmium (NiCd)
- Nickel Metal Hydride



25. Firstly, I note that the above does not list the “N Battery” under nickel battery sizes. Secondly, nickel is, again, clearly shortened to its chemical symbol “Ni”.

26. **Exhibit ES4** contains extracts from the applicant’s website and articles from 2022 confirming that the applicant has “officialised the launch of the high-nickel ternary (NCM NCMA) battery”.

27. Lastly I note that **exhibit ES5** contains 3 decisions from the United States Patent and Trademark Office (USPTO), the European Intellectual Property Office (EUIPO) and the UK Intellectual Property Office (UKIPO).

28. Firstly, and as noted by Ms Sharkey, this Tribunal is not bound by the decisions of the USPTO, EUIPO or even the UKIPO. I am not aware of the law or practices which would have been applied by both the EUIPO and the USPTO on determining absolute grounds. I also do not have the evidence before me that was presented to both offices, which would have had an impact on their final decision. However, I note that the EUIPO found the sign “NBattery” descriptive for all of the applicant’s goods and services in classes 9, 12 and 37. I note that the USPTO found the sign “NBattery” descriptive of the class 9 battery goods, however, requested the applicant to confirm that for its goods and services in class 12 and 37, whether they will use “N” size batteries, and whether they have anything to do with “N” size batteries.

29. Thirdly, I note that the decision made by the UKIPO is not in relation to absolute grounds (section 3), but in relation to relative grounds (section 5). Within this decision, the Hearing Officer concluded that the letter “N” had “no apparent meaning”, but Ms Sharkey states that this is on the basis that there was no evidence presented that “N” is the descriptor of a size of battery.

Conclusions

30. As noted above, the majority of the opponent’s evidence is dated after the relevant date. However, in any event, there is an element to futurity to the assessment under section 3(1)(c), by virtue of the wording of the provision “may serve in trade”. It is not necessary that the sign in question is actually used in a way that is descriptive for it to

fall foul of section 3(1)(c). It is sufficient if the sign could be used for such purposes. The lack of evidence prior the relevant date of such use is not, therefore, fatal to the opposition.

31. The word battery is an ordinary dictionary word and concept known to the average consumer. The word by itself, would be clearly descriptive of the applicant's class 9 battery goods, and descriptive of a characteristic of the applicant's class 12 electric vehicles and class 37 services in relation to batteries and electric vehicles.

32. However, in this case, the mark as a whole, "NBattery", is a newly coined, invented term, made from the letter "N" and the word "Battery". Therefore, the crux of establishing whether the sign "NBattery" is descriptive of the applicant's goods and services is reliant upon the opponent establishing that the letter "N" is also descriptive or could be used descriptively.

33. Firstly, and for the sake of completeness, I note that Ms Sharkey has argued that the letter "N" may be understood as a reference to batteries containing nickel. I am not persuaded by this argument. Albeit the evidence provided, which falls before and after the relevant date, shows that nickel is used within batteries, it does not establish that the average consumer would know, use or recognise the term nickel being abbreviated to the letter "N". This is on the basis that every article provided within the evidence refers to nickel by its chemical symbol "Ni".

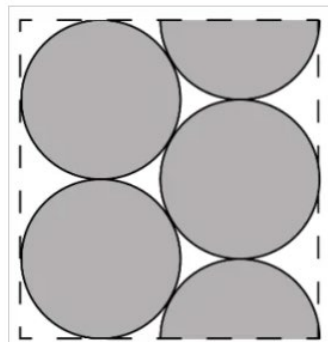
34. As summarised within the opponent's submissions in lieu, the "N Battery" is a standard size of alkaline battery with the length of 30.2mm and diameter of 12.0mm. I note that the opponent submits that as highlighted by its evidence within **ES02**, the consumer would be familiar with the "N Battery", with the letter "N" denoting its size, because of the way alkaline batteries are marketed (for example labelled as D, C, N, AA, AAA and AAA batteries).

35. In an article from EDF energy, titled "All about electric car batteries", it states that "EVs don't use a single battery like a phone, they use instead a pack which is comprised of thousands of individual Li-ion cells working together. When the car's charging up, electricity is used to make chemical changes inside its batteries". I also

note that the following depiction is contained within this article of the “electric car battery lithium-ion”:



36. Furthermore, in the “ALL ABOUT CIRCUITS” article from 14 October 2020, it notes that when combining cylindrical cells into pack and modules, it may not utilize the space available, however, the space cavities allows the coolant to easily circulate around the cells within a battery pack. The following depiction is shown alongside this explanation:



37. This article furthermore states that “in terms of size, cylindrical cells are usually produced in standard models. One common size is the 18650 type (18 mm diameter, 65 mm height)”, and that these batteries are also used in Tesla vehicles. I note that

this measurement is not far off from the N batteries measurements (12.0mm diameter, 30.2 mm height).

38. It is therefore clear, from the above, that the sign “NBattery” would be recognised and understood by the average consumer, as descriptive of a size and type of alkaline battery. It is also clear that multiple smaller batteries, otherwise known as cells, are packed together to form an electric vehicle’s battery. These smaller batteries are cylindrical in nature, which as highlighted above, is the shape of both the alkaline N battery and lithium-ion batteries used in electric vehicles. On this basis, I consider that in the future, engines of electric vehicles could be made up of multiple batteries, which are “N” sized, and that the manufacturers could use the same size grading system including the letter N, and other letters such as AA and AAA. I note that this is further supported by the evidence explored above, where a screenshot from primetenders.com listed the “LEAD ACID NBATTERY” as already being used “for motor vehicle voltage”.

39. Furthermore, I consider that it is reasonably foreseeable that the contested mark could be used descriptively in the future due to the exponential growth in the field of technology, which would also include the research and development of batteries and electric vehicles. I consider that at the rate in which technology changes and develops, significant advancements could be made so that “N” sized batteries are used in vehicles in the future.

40. Therefore, albeit there is no evidence that “NBattery” is currently descriptive of the class 9, 12 and 37 battery and vehicle based goods and services, it is reasonably foreseeable that with the advancement of technology, that multiple N sized batteries could be used to create one larger battery within electric vehicles, and that the size of these batteries will still be indicated by the same lettering system, and the same letter; N.

41. The opposition under section 3(1)(c), therefore, succeeds for the following goods and services, where the mark “NBattery” is either descriptive of the goods, or descriptive of a characteristic of the goods and services:

- Class 9 Batteries, electric, for vehicles; charging stations for electric vehicles; Charging devices for motor vehicles.
- Class 12 Electric vehicles; motorcycles; driverless cars [autonomous cars]; remote control vehicles, other than toys; motor coaches; sprinkling trucks; trucks; mine cars; motorcycles; motor buses; cars; Land vehicles; garbage trucks; tramcars; forklift trucks; vehicles for locomotion by land, air, water or rail; Electric self-balancing cars; electric bicycles; Mopeds; civilian drones; air vehicles; water vehicles; ferry boats.
- Class 37 Providing information relating to repairs; electric appliance installation and repair; machinery installation, maintenance and repair; rebuilding machines that have been worn or partially destroyed; interference suppression in electrical apparatus; vehicle maintenance; vehicle breakdown repair services; vehicle battery charging; charging of electric vehicles; vehicle service stations [refuelling and maintenance]; Motor vehicle charging services.

42. However, for the applicant's remaining class 9 goods; "computer software platforms recorded or downloadable", "downloadable mobile application software" and "computer software applications, downloadable", and class 37 "maintenance and repair of computer hardware" and "vehicle cleaning" services, I do not consider that use of the sign "NBattery" is descriptive of them, or a characteristic of them.

43. The opponent argues that the software goods in class 9 are "essential for the functioning of electric cars of which a battery is the most essential part", and that the application "will be perceived as indicating the intended use of the goods, namely a battery type or size that fits or supports these products".

44. Firstly, I note that the opponent has not provided any evidence to support the above submissions. The evidence only indicates that devices such as cell phones and laptops use lithium-ion batteries to power them, not the software itself. Secondly, albeit electric vehicles, for example, may use both a battery and computer software in order for the vehicle to work, they are clearly separate components that perform completely

different functions. On this basis, I consider that the opponent's above submissions that the sign "NBattery" is descriptive of the computer software goods and services, or a characteristic of them, is a step too far removed.

45. The applicant's class 37 "maintenance and repair of computer hardware" services also have no connection to batteries. Firstly, I note that computer hardware does not include batteries, it includes, for example, the central processing unit, hard drive and random access memory. Secondly, I have not been provided with any evidence that computer hardware, such as hard drives, also use batteries, and therefore, it cannot be concluded that the sign "NBattery" is descriptive of these services.

46. The same applies for the applicant's class 37 "vehicle cleaning" services. Albeit the vehicle has a battery, the cleaning services would include washing and polishing the body of the car, and could even include cleaning of the interior, such as vacuuming the seats and floor. It does not have anything to do with the vehicle's battery, and thus the sign "NBattery" is not descriptive.

Section 3(1)(b)

47. I now turn to the opposition based upon section 3(1)(b). I note the Form TM7 does not appear to set out any independent basis for the opposition under this ground, other than the arguments set out above regarding the descriptive nature of the mark.

48. Section 3(1)(b) prevents registration of marks which are devoid of distinctive character. The principles to be applied under article 7(1)(b) of the CTM Regulation (which is now article 7(1)(b) of the EUTM Regulation, and is identical to article 3(1)(b) of the Trade Marks Directive and s.3(1)(b) of the Act) were conveniently summarised by the CJEU in *OHIM v BORCO-Marken-Import Matthiesen GmbH & Co KG* (C-265/09 P) as follows:

"29..... the fact that a sign is, in general, capable of constituting a trade mark does not mean that the sign necessarily has distinctive character for the purposes of Article 7(1)(b) of the regulation in relation to a specific product or

service (Joined Cases C-456/01 P and C-457/01 P *Henkel v OHIM* [2004] ECR I-5089, paragraph 32).

30. Under that provision, marks which are devoid of any distinctive character are not to be registered.

31. According to settled case-law, for a trade mark to possess distinctive character for the purposes of that provision, it must serve to identify the product in respect of which registration is applied for as originating from a particular undertaking, and thus to distinguish that product from those of other undertakings (*Henkel v OHIM*, paragraph 34; Case C-304/06 P *Eurohypo v OHIM* [2008] ECR I-3297, paragraph 66; and Case C-398/08 P *Audi v OHIM* [2010] ECR I-0000, paragraph 33).

32. It is settled case-law that that distinctive character must be assessed, first, by reference to the goods or services in respect of which registration has been applied for and, second, by reference to the perception of them by the relevant public (*Storck v OHIM*, paragraph 25; *Henkel v OHIM*, paragraph 35; and *Eurohypo v OHIM*, paragraph 67). Furthermore, the Court has held, as OHIM points out in its appeal, that that method of assessment is also applicable to an analysis of the distinctive character of signs consisting solely of a colour per se, three-dimensional marks and slogans (see, to that effect, respectively, Case C-447/02 P *KWS Saat v OHIM* [2004] ECR I-10107, paragraph 78; *Storck v OHIM*, paragraph 26; and *Audi v OHIM*, paragraphs 35 and 36).

33. However, while the criteria for the assessment of distinctive character are the same for different categories of marks, it may be that, for the purposes of applying those criteria, the relevant public's perception is not necessarily the same in relation to each of those categories and it could therefore prove more difficult to establish distinctiveness in relation to marks of certain categories as compared with marks of other categories (see Joined Cases C-473/01 P and C-474/01 P *Proctor & Gamble v OHIM* [2004] ECR I-5173, paragraph 36; Case C-64/02 P *OHIM v Erpo Möbelwerk* [2004] ECR I-10031, paragraph 34; *Henkel v OHIM*, paragraphs 36 and 38; and *Audi v OHIM*, paragraph 37)."

49. As previously established, I have already found that the applicant's mark is exclusively descriptive under section 3(1)(c) for some of its goods and services. Consequently, I consider that the applicant's mark, when used on those same goods and services for which the mark is applied for, will not be viewed as indicative of trade origin due to its descriptive nature and will, therefore, be non-distinctive.

50. However, for the remaining goods and services, I have found that applicant's mark is not descriptive under section 3(1)(c). I accept that this does not, of itself, mean that the applicant's mark cannot be objectionable under section 3(1)(b). However, descriptiveness is the only claim that the opponent has made under this ground as to why the mark is devoid of distinctive character (because it "simply informs the relevant public of a type or size of battery or the goods and services concerned consist of or have nickel-containing batteries").

51. It is clear from the case law that for a mark to possess distinctive character, it must serve to identify the goods or services in issue as originating from a particular undertaking. I can see no reason why the mark as a whole, not being descriptive of the goods and services in issue, would be incapable of identifying those goods and services as originating from a particular undertaking. I consider that the use of the "N" element, in combination with the word "Battery", would indicate a particular organisation.

52. The opposition under section 3(1)(b) also partially succeeds.

CONCLUSION

53. The opposition is partially successful under sections 3(1)(c) and 3(1)(b) in respect of the following goods and services, for which the application is refused:

Class 9 Batteries, electric, for vehicles; charging stations for electric vehicles;
Charging devices for motor vehicles.

Class 12 Electric vehicles; motorcycles; driverless cars [autonomous cars];
remote control vehicles, other than toys; motor coaches; sprinkling

trucks; trucks; mine cars; motorcycles; motor buses; cars; Land vehicles; garbage trucks; tramcars; forklift trucks; vehicles for locomotion by land, air, water or rail; Electric self-balancing cars; electric bicycles; Mopeds; civilian drones; air vehicles; water vehicles; ferry boats.

Class 37 Providing information relating to repairs; electric appliance installation and repair; machinery installation, maintenance and repair; rebuilding machines that have been worn or partially destroyed; interference suppression in electrical apparatus; vehicle maintenance; vehicle breakdown repair services; vehicle battery charging; charging of electric vehicles; vehicle service stations [refuelling and maintenance]; Motor vehicle charging services.

54. The application can proceed to registration in respect of the following goods and services for which the opposition has been unsuccessful:

Class 9 Computer software platforms recorded or downloadable; Downloadable mobile application software; computer software applications, downloadable.

Class 37 Installation, maintenance and repair of computer hardware; vehicle cleaning

COSTS

55. The opponent has enjoyed a greater degree of success in the opposition and is entitled to a contribution towards its costs, based upon the scale published in Tribunal Practice Notice 2/2016. I will make an appropriate reduction in the award of costs made to reflect the opponent's only partial success. In the circumstances, I award the opponent the sum of **£900** as a contribution towards the costs of the proceedings. The sum is calculated as follows:

Filing a Notice of opposition and considering the applicant's counterstatement	£150
--	------

Preparing and filing evidence	£350
Preparing and filling written submissions in lieu	£200
Official Fee	£200
Total	£900

56. I therefore order Contemporary Amperex Technology Co., Limited to pay Caterpilla Inc. the sum of £800. This sum is to be paid within 21 days of the expiry of the appeal period or, if there is an appeal, within 21 days of the conclusion of the appeal proceedings.

Dated this 11th day of August 2023

L FAYTER
For the Registrar